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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,931	01/26/2001	John H. Schneider	00.05.12.1	8223

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 10/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/770,931

Applicant(s)

SCHNEIDER ET AL.

Examiner

Gina C. Yu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-33 is/are pending in the application.
- 4a) Of the above claim(s) 29,32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

P r i r i t y under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of alkaline earth metal hydroxides as the "first chemical composition"; polyaziridines as the "cross linking agent"; and silica as the "second material" in Paper No. 5 is acknowledged. Claims 16-28, and 30-31 read on the elected invention. Claims 29, 32, and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

The traversal is on the ground(s) that the requirement could be burdensome to the applicants. This is not found persuasive because the election requirement is proper when claims present multiple inventions and species that are unrelated and diverse as in this case. See MPEP § 808.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 26 and 27 are objected to, as the claims do not end with a period. Each claim must begin with a capital letter and ends with a period. See MPEP 608.01 (m). Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 16, 18, 20, 21, 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walles et al. (US 4756844) ("Walles") in view of Vijayendran et al. (US 5173526) ("Vijayendran").

Walles teaches controlled-release composition having a water permeable membrane comprising submicron particles (anticoalescent agents), which encapsulate a liquid or solid active agent. See abstract. Aqueous colloidal silica is a preferred anticoalescent agent. See col. 5, line 44 – col. 7, line 17. While the Walles invention uses submicron silica, examiner views it obvious for a skilled artisan to have discovered workable particle size by routine experimentation.

The reference teaches that the permeable membrane is applied as a coating to the agent, forming a capsule. Coating materials such as polystyrene, acrylic acid polymers, and synthetic latexes as disclosed as the membrane materials suitable for the prior art invention. See col. 5, lines 7 – 43. The reference teaches that uncoated diameter of core agents can be in the range of 0.04-3 mm. See col. 7, line 58 – col. 8, line 20; instant claims 21 and 23. There the reference also teaches that the skilled artisan would have decided the membrane thickness depending on the presence of ions and salts and the pH in the carrier liquid, etc. See instant claim 21.

Walles fails to teach polyurethane-vinyl polymers.

Vijayendran teaches polyurethane-vinyl hybrid polymer useful as a protective coating material. The reference teaches that the invention is economically advantageous over the conventionally known coating materials such as polystyrene. See col. 1, lines 15 – 42. Examiner notes that the limitation following "prepared by"

ending at "thereby form a urethane/vinyl hybrid polymer" is a process, which will not be given patentable weight in this product claim. See MPEP § 2113.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Walles by substituting the polyurethane-vinyl polymer as suggested by Vijayendran because of the expectation of successfully producing controlled-release composition with cost efficiency.

2. Claims 19, 22, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walles and Vijayendran as applied to claims 16, 18, 20, 21, and 23-28, and further in view of Garcia et al. (US 6436540 B1) ("Garcia").

While Vijayendran teaches the addition of crosslinking agents, the combined references fail to teach using polyaziridines.

Garcia teaches that polyaziridines are conventionally used in crosslinking polyurethane/polyvinyl hybrid polymers. See Examples 1-4 and Table 1.

It is prima facie obvious to substitute equivalents for same purposes so long as the equivalency is recognized in the prior arts. See MPEP § 2144.06.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by substituting the crosslinking agents there with another conventionally used crosslinking agent polyaziridines, as suggested by Garcia, because of the expectation of successfully producing a composition of similar effects.

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3. Claim 17 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Walles and Vijayendran as applied to claims 16, 18, 20, 21, 23-28 above, and further in view of Newlove et al. (US 5948735) ("Newlove").

Walles and Vijayendran, discussed above, fail to teach alkaline earth hydroxide.

Newlove teaches that calcium hydroxide, an alkaline earth hydroxide, is a conventional breaker particles used in the treatment of subterranean formations. See col. 8, lines 20-59. The invention is directed to the use of encapsulated particles of breaker chemicals. See col. 1, lines 5 – 28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of the combined references by substituting the active agents with calcium hydroxide as suggested by Newlove because of the expectation of successfully producing encapsulated breaker chemicals.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
October 19, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

10/21/02